

## REMARKS & ARGUMENT

With this amendment the applicant has presented 6 sheets of formal drawings comprising Figure 1-6 to replace the corresponding 6 sheets of informal drawings already on file.

5 With this amendment the applicant has canceled claims 3-11 and 13-17. So active pending claims are 1, 2, 12 and 18-20.

Claims 1, 2 and 12 stand rejected under 35 USC 103(a) as being obvious over '106 Foley et al Applicants revised claims call for "randomizer" and "object" which Foley does not teach.

10 Applicant's randomizer is not limited to the cube or dice. The randomizer can be spinner, flash cards, a bingo type version where chips with colors or printed graphics on them can be pulled out of a bag or like the lotto game, an electronic version of a spinner or a person who announces the color, numbers or graphics given as a set. The applicant's embodiment is more versatile and flexible. The  
15 randomizer can have versatility like the holistic game itself where when the randomizer is cast, it can be kicked before it comes to rest to add more thrill to the game.

The 3D object used in the game is not limited to using mats for bases for the players to stand on. Players can pick them up instead of standing on them. It can be  
20 3 dimensional object such as small colored balls that can be picked up and held, small flags that stand upright, even objects that can float or sink which can be played in the pool during warm weather, glow in the dark objects for playing after dusk in the dark, balloons that the players have to grab and instead of removing the object, it can be popped to acts as single user disposable game except for the  
25 randomizer and the playing objects, pieces or bases can be small enough to be pinned to trees or backyard fence.

**Foley et al '106 mats consist of four convex sides and four concave sides.**

**Applicant's game doesn't necessarily use mats as it calls for objects. It can use any 3D objects. If mats are used, they can be a square or round mats with graphics printed on them or the mats can be cut to different shapes such as stars, heart, etc.**

5       **In Foley's embodiment players are limited within the playing patterned mats that must be reachable by the players without losing contact with the other mats. Mats must be spaced apart and still permits the limbs of a person to contact them.**

10       **Applicant's holistic game can be randomly distributed or in a patterned method over the play area. It can be distributed without any limitation on distance between other mats or bases. The players do not need to be in constant contact with the game pieces or mats.**

15       **Furthermore in Foley's configuration the mats cannot be randomly placed on the ground. In applicant's holistic game if the objects are bases or mats, they can be place on the ground randomly or in a patterned way and can be rearranged again after each player is removed from the game.**

20       **In Foley's embodiment players must be facing each other when played, whereas in the applicants embodiment players need not face each other. Players run to the objects or acquire the objects quickly. The player that doesn't have the indicated graphics on the randomizer is taken out of the game**

25       **The object of Foley's game is not to touch the playing field on which the mats are placed. If a player loses footings or touch the floor, the team loses. In sharp contrast the object of applicant's game is to be the last one to be in possession of the object or standing on the game piece which is similar to musical chairs.**

30       **Claims 18-20 also stand rejected under 35 USC 103(a) over Foley et al further in view of Sieve '754. There is no suggestion let alone teaching as to how to combining the two embodiments.**

Sieves game deals with teaching players basic arithmetic. Numbers must be added in order to get a high number. Since this is so, his game cannot have other graphics on the randomizer. The applicant's holistic game is strictly a visual game which obviates arithmetic

5           Sieves' game must be played within close proximity from each other such as the dinning table. The applicant's game has no such limitation. The game pieces such as the bases can be scattered or placed closely within each other.

10           Furthermore Sieves' game is limited to N dice such as 6,8 12, etc. The applicant's game although can use a dice but is not limited to it as the randomizer can be of many different types.

          Claims 19-20 also stand rejected under 35 USC 112 second para as being indefinite. With this amendment the applicant has obviated this rejection by differentiating claims 19 and 20.

15           It is further applicant's position that the applicants invention is simply elegant and therefore may appear obvious in hindsight but in reality it is any thing but obvious. This is substantiated by the fact that the recognized need has remained unmet until this inventor provided the spark of genius.

20           Unfortunately (but fortunately for the applicant) there is no suggestion to combine anything in any of the prior art patents cited by the examiner let alone knowledge or teaching of:

          a) What to combine with what?

          b) How many to combine and in what order

          c) How to combine;

          d) Why to combine; and

25           e) What obvious result will emerge from such myriads of permutations and combinations of trial and error of selecting a few patents and publications from an endless supply all over the world?

The courts have consistently required the examiner to identify where the prior art provides a motivating suggestion for the modification, as for example in the decision in *In Re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992) where the court held:

5           ‘Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so....*In re Fine*, 837F.2d 1071, 1074, 5 USPQ.2d 1596, 1598-99 (Fed. Cir. 1988) at 1943.

10           More over the Federal Circuit has advocated that even if the prior art may be modified as suggested by the examiner, the modification is not obvious unless the prior art suggests the desirability for the modification, as for example in *In Re Fitch*, 922 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992), where the court held:

15           Mere fact that the prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by prior art....” [1780]

          The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested desirability of the modification. *In re Gordon*, 733 F.2d 902, 221 USPQ 1127 [1783]

20           Interestingly it has been most recently set forth that the motivating suggestion must be explicit, as was decided in the seminal case of *Winner International Royalty Corp. v/s Wang*, No. 962107, 48 USPQ.2d 1139 (D.C. 1998) where the court held:

          “ ... invention cannot be found obvious unless there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention. “ [at 1140]

25           “ ... there must have been some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine such elements so as to create the same invention. “ [at 1144]

## **SIMPLICITY AND ELEGANCE IS NOT OBVIOUS**

It is ironic that such a simple invention has escaped the experts for such a long time. The applicants invention is simply elegant and therefore may appear obvious in hindsight but in reality it is any thing but obvious. In retrospect the applicant's invention appears simple, but this simplicity is elegant and non-obvious and is the hallmark of most ingenious good inventions. Simplicity does not negate non-obviousness. "The subject matter as a whole" in 35 USC 103, is particularly problematic in simple inventions.

In 1908, the United States Supreme Court, in *Expanded Metal Co. v. Bradford*, 214 U.S. 366, 381, 29 S.Ct. 652, 53 L.Ed.1034, 1039 said, "The fact that the invention seems simple after it is made does not determine the question; if this were the rule, many of the most beneficial patents would be stricken down."

In 1959, Circuit Judge Medina, in a case in the Second Circuit Court of Appeals (*American Safety Table Co v/s Schreiber*, 269 F.2d 255, 263, 122 USPQ 29,36 said, " In the last analysis the burden of *Schreiber & Goldberg's* attack on the first patent for lack of invention comes down to its simplicity.

But experience in practically every field of human endeavor has demonstrated that the very simplicity of a new idea is the truest and most reliable indication of novelty and invention, when others have devoted extensive effort and exhausted their resourcefulness in a futile search for the solution of the same vexing problem.

*Potts v. Creager*, 1895,155 U.S. 597, 608, 15 S.Ct.194, 39 L.Ed. 275; *Lyon v. Bausch & Lomb Optical Co.*, 2 Cir., 1955, 224 F.2d 530,534, certiorari denied 350 US 911, 76 S.Ct. 193; *H C White v. Morton E. Converse & Son Co.*, 2 Cir., 1927, 20 F.2d 311, 313, certiorari denied, 275 U.S. 5.47, 48 S.Ct. 85, 72 L.Ed. 419.

## **DANGERS OF HINDSIGHT**

The Supreme Court, in *Calmar, Inc. v. Cook Chemical Co.* (383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966)) mentioned the danger of "slipping into hindsight," citing the case of *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co.*, 332 F.2d 406, 141 USPQ 549 (6th Cir.1964) said,

" We must view the prior art from the point in time just prior to when the patented device was made. Many things may seem obvious after they have been made and for this reason the courts should guard against slipping into use of hindsight.

We must be careful to "view the prior art without reading into that art the teachings of appellant's invention." Application of *Sporck*, 301 F.2d 686, 689 (CCPA).

Its the applicant's position that Justice Frankfurter was quite right in his dissent in *Marconi Wireless Telegraph Co. v. United States*, 320 U.S.1, 60, 63 S.Ct.1393, 1421, 87 L. Ed.1731, 1763 (1943)

" The discoveries of the science are the discoveries of the laws of nature and like nature do not go by leaps. Even Newton and Einstein, Harvey and Darwin built on the past and on their predecessors. Seldom indeed has a great discoverer or inventor wandered lonely as a cloud.

Great inventions have always been parts of an evolution; the culmination at a particular moment of an antecedent process. So true is this that the history of thought records striking coincidental discoveries-showing that the new insight first declared to the world by a particular individual was "in the air" and ripe for discovery and disclosure.

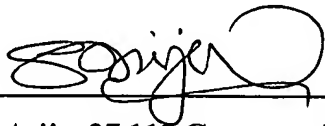
The real question is how significant a jump is the new disclosure from the old knowledge. Reconstruction by hindsight, making obvious something that was not at all obvious to superior minds until someone pointed it out, - this is too often a tempting exercise for astute minds. The result is to remove the opportunity of obtaining what Congress has seen fit to make available."

Applicants game is also quite different from the other prior art cited by the examiner or known to the applicant. Penderson '228 game includes sheet material defining a confined playing area, where as applicants game entails 3D objects such as mats or bases. In Penderson More than one player maybe eliminated in a round, where as in applicants embodiment only one person at a time can be eliminated. Penderson also uses sound or music as the randomizer. Applicant's game does not utilize any sound producing device. The players of Penderson's game must go around the sheet material and stand on the colored areas of the sheet material. The applicants embodiment has no such restrictions as applicant's game is not confined to a sheet

Furthermore it is the applicant's position that unlike the facts of In re Gulack 217 USPQ 401 (CAFC 1983), there is a functional relationship between the graphics and the holistic game. In fact the graphics are so integrated with the game that it is impossible to separate the two without adverse affect on the enjoyment of the game. Besides that decision was issued in the era before the patents for business and game methods came into vogue.

In conclusion it is the applicant's position that the inventor with this amendment has overcome all the objections of the examiner and has otherwise complied with all the requirements of the examiner and a "notice of Allowance" is earnestly solicited.

Respectfully Submitted



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